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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,913	10/19/2001	Kazunori Sato	A322-1	7289

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EXAMINER

WU, RUTAO

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.: 09/981,913	Applicant(s) SATO, KAZUNORI	
	Examiner Rutao Wu	Art Unit 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2001.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some * c) ☐ None of:
 - 1. ☒ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/02, 6/02, 5/04</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 6-9, 11, 12, 14-16, 18-21, 24-27, 29, 30, 32-34, 36 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat No. 6035281 to Crosskey et al.

Referring to claim 1:

An accounting system used for a wireless communication system in which a data transmitter transmits data to a data receiver through a network, comprising:

(a) a data server storing therein data transmitted from said data transmitter; and

(col 5: lines 1-5)

(b) a calculator calculating a fee payable to communication between said data transmitter and said data receiver, (col 4: lines 59-63)

wherein when said data receiver receives data stored in said data server, if said data transmitter is a predetermined one, said calculator charges said data transmitter for communication between said data transmitter and said data receiver. (col 3: lines 29-35; col 4: lines 18-22)

Referring to claim 2:

The accounting system as set forth in claim 1, wherein said calculator charges said data receiver for said communication, if said data transmitter is not said predetermined one. (col 4: lines 1-2; col 6: lines 20-22)

Referring to claim 3:

The accounting system as set forth in claim 1, wherein said communication is packet communication, and said fee is calculated by said calculator in accordance with packet counts. (col 3: lines 41-45)

Referring to claim 6:

The accounting system as set forth in claim 1, wherein when said data receiver receives data stored in said data server, said data server makes judgment as to whether said data transmitter is a predetermined one, and, if said data transmitter is said predetermined one, said data server informs said calculator that said data transmitter is said predetermined one, and of an amount of data having been transmitted to said data receiver from said data transmitter. (col 3: lines 29-35; col 4: lines 18-22; col 5: lines 61-63)

Referring to claim 7:

An accounting system used for a wireless communication system in which a data transmitter transmits data to a data receiver through a network, comprising:

- (a) a data server storing therein data transmitted from said data transmitter; and
- (col 5: lines 1-5)

(b) a calculator calculating a fee payable to communication between said data transmitter and said data receiver, (col 4: lines 59-63)

wherein when said data receiver receives data stored in said data server, if a specific code is attached to said data by said data transmitter, said calculator charges said data transmitter for communication between said data transmitter and said data receiver. (col 6: lines 18-34)

Referring to claim 8:

The accounting system s set forth in claim 7, wherein said specific code is comprised of a ciphered code. (col 6: lines 18-34)

Referring to claim 9:

The accounting system as set forth in claim 7, wherein said specific code is provided to said data transmitter from said data server upon a request from said data transmitter. (col 6: lines 18-34)

Referring to claim 11:

The accounting system as set forth in claim 7, wherein said calculator charges said data receiver for said data, if said specific code is not attached to said data. (col 6: lines 18-34)

Referring to claim 12:

The accounting system as set forth in claim 7, wherein said communication is packet communication and said fee is calculated by said calculator in accordance with packet counts. (col.3: lines 41-45)

Referring to claim 14:

An accounting system used for a wireless communication system in which a home-page presenter transmits data to a user through a network, comprising:

(a) a data server storing therein data transmitted from said home-page presenter;
and (col 5: lines 1-5)

(b) a calculator calculating a fee payable to communication between said home-page presenter and said user, (col 4: lines 59-63)

wherein when said user makes access to a home-page on which said data stored in said data server is displayed, if said home-page presenter is a predetermined one, said calculator charges said home-page presenter for said access made by said user to said home-page. (col 11: lines 66-67; col 12: lines 1-2)

Referring to claim 15:

The accounting system as set forth in claim 14, wherein said calculator charges said user for said access, if said home-page presenter is not said predetermined one.
(col 11: lines 66-67; col 12: lines 1-2)

Referring to claim 16:

The accounting system as set forth in claim 14, wherein said communication is packet communication, and said fee is calculated by said calculator in accordance with packet counts. (col 3: lines 41-45)

Referring to claim 18:

The accounting system as set forth in claim 14, wherein when said user receives data stored in said data server, said data server makes judgment as to whether said home-page presenter is a predetermined one, and, if said home-page presenter is said

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predetermined one, said data server informs said calculator that said home-page presenter is said predetermined one, and of an amount of data having been transmitted to said user from said home-page presenter. (col 3: lines 29-35; col 4: lines 18-22; col 5: lines 61-63)

Referring to claim 19:

A method of settling accounts in a wireless communication system in which a data transmitter transmits data to a data receiver through a network, comprising the steps of:

(a) calculating a fee payable to communication between said data transmitter and said data receiver; (col 4: lines 59-63)

(b) checking whether said data transmitter is a predetermined one; and (col 3: lines 29-31; col 4: lines 18-22)

(c) charging said data transmitter for said communication, if said data transmitter is said predetermined one. (col 3: lines 31-35; col 5: lines 61-63)

Referring to claim 20:

The method as set forth in claim 19, further comprising the step of charging said data receiver for said communication, if said data transmitter is not said predetermined one. (col 4: lines 1-2; col 6: lines 20-22)

Referring to claim 21:

The method as set forth in claim 19, wherein said communication is packet communication, and said fee is calculated in said step (a) in accordance with packet counts. (col 3: lines 41-45)

Referring to claim 24:

The method as set forth in claim 19, further comprising the steps of:

(d) making judgment as to whether said data transmitter is a predetermined one;
and (col 3: lines 29-31; col 4: lines 18-22)

(e) informing a fee calculator that said data transmitter is said predetermined one, and of an amount of data having been transmitted to said data receiver from said data transmitter, if said data transmitter is said predetermined one. (col 3: lines 31-35, 41-45; col 5: lines 61-63)

Referring to claim 25:

A method of settling accounts in a wireless communication system in which a data transmitter transmits data to a data receiver through a network, comprising the steps of:

(a) calculating a fee payable to communication between said data transmitter and said data receiver; (col 4: lines 59-63)

(b) checking whether a specific code is attached to data by said data transmitter;
and (col 6: lines 18-34)

(c) charging said data transmitter for said communication, if said specific code is attached to said data. (col 6: lines 18-34)

Referring to claim 26:

The method as set forth in claim 25, wherein said specific code is comprised of a ciphered code. (col 6: lines 18-34)

Referring to claim 27:

The method as set forth in claim 25, further comprising the steps of:

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(d) making a request to a charger to assign said specific code to said data transmitter, said step (d) being to be carried out by said data transmitter; (col 6: lines 18-34)

(e) assigning said specific code to said data transmitter in response to said request, said step (e) being to be carried out by said charger; and (col 6: lines 18-34)

(f) applying said specific code to said data, said step being to be carried out by said data transmitter. (col 6: lines 18-34)

Referring to claim 29:

The method as set forth in claim 25, further comprising the step of charging said data receiver for said data, if said specific code is not attached to said data. (col 6: lines 18-34)

Referring to claim 30:

The method as set forth in claim 25, wherein said communication is packet communication, and said fee is calculated in said step (a) in accordance with packet counts. (col 3: lines 41-45)

Referring to claim 32:

A method used for a wireless communication system in which a homepage presenter makes communication with a user through a network, comprising the steps of:

(a) calculating a fee payable to communication between said home-page presenter and said user; (col 4: lines 59-63)

(b) checking whether said home-page presenter is a predetermined one; and (col 11: lines 41-44)

(c) charging said home-page presenter for said communication, if said home-page presenter is said predetermined one. (col 11: lines 66-67; col 12: lines 1-2)

Referring to claim 33:

The method as set forth in claim 32, further comprising the step of charging said user for said communication, if said home-page presenter is not said predetermined one. (col 11: lines 66-67; col 12: lines 1-2)

Referring to claim 34:

The method as set forth in claim 32, wherein said communication is packet communication, and said fee is calculated in said step (a) in accordance with packet counts. (col 3: lines 41-45)

Referring to claim 36:

The method as set forth in claim 32, further comprising the steps of:

(d) making judgment as to whether said home-page presenter is a predetermined one; and (col 11: lines 41-44)

(e) informing a fee calculator that said home-page presenter is said predetermined one, and of an amount of data having been transmitted to said user from said home-page presenter, if said home-page presenter is said predetermined one. (col 3: lines 41-45; col 11: lines 66-67; col 12: lines 1-2)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4, 5, 10, 13, 17, 22, 23, 28, 31, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crosskey et al.

As per claims 4, 13, 22, 31, Crosskey et al disclose that the server stores hypertext objects, such as HTML files, graphical icon files (e. g. GIF files), audio, video objects and CGI programs, on its local disk and provides these objects to various clients using HTTP through the Internet. (col 5: lines 1-5)

Crosskey et al did not explicitly state that data transferred between the servers are e-mails.

However, the difference between the information Crosskey et al disclosed as stored in the server and e-mails are only found in the non-functional descriptive material and are not functionally involved in the steps recited. The receiving, storing and providing steps would be performed the same regardless of the descriptive material since none of the steps explicitly interact therewith. Limitations that are not functionally interrelated with the useful acts, structure, or properties of the claimed invention carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Ngai*, 70 USPQ2d 1862 (CAFC 2004); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would also have been obvious to a person of ordinary skill in the art at the time of applicant's invention to transfer and storing e-mails between servers and

users because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claims 5, 17, 23, 35, Crossket et al does not explicitly disclose that predetermined one is a person who has made an accounting contract in advance with a provider. Crossket et al does disclose determining participating parties as being responsible for the billing. It is obvious to one having ordinary skill in the art at the time the invention was made that to be a participating party for billing, a contract or registration must be agreed upon between the parties.

As per claims 10, 28, Crossket et al does not explicitly disclose the data server removes said specific code from data and transmits the data to the data receiver. Crossket et al does disclose codes that distinguish billable participating parties are embedded in the hyperlink target. When users access the hyperlink target to receive the wanted data the proxy server stores the codes and us it to determine if the target content provider as being responsible for payment or the source content provider as being responsible for payment (col 6-11). Therefore, it is obvious to one skilled in the arts to see that the code and data are separated from the data when the user accesses the hyperlink target.

Conclusion

1. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

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Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to cost accounting for data transmission.

U.S. Pat No. 5,508,817 to Kunigami.

U.S. Pat No. 5,864,606 to Hanson et al.

U.S. Pat No. 5,893,903 to Eisdorfer et al.

U.S. Pat No. 6,240,402 to Lynch-Aird.

U.S. Pub No. 20030119473 to Asada et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rutao Wu whose telephone number is (571)272-3136.

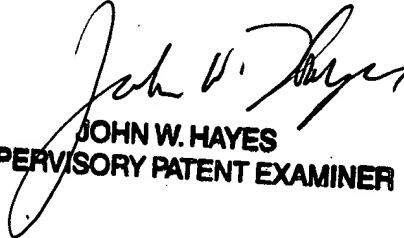
The examiner can normally be reached on Mon-Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

rw


JOHN W. HAYES
SUPERVISORY PATENT EXAMINER